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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/922,869
Filing Date: August 07, 2001
Appellant(s): MAKISHIMA ET AL.

Michael R. Cammarata
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/25/07 appealing from the Office action mailed 1/20/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

A statement identifying by name the real party in interest is contained in the brief.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 6/14/07 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al (US 6,771,896) in view of Parulski et al (US 6,573,927) and Attenberg (US 5,913,019).

Regarding claim 1: Tamura teaches a print system (fig. 4) comprising: a housing (the housing of 220 or 210, fig. 4, fig. 3), an input unit (211, fig. 4 or the input device that is receiving inputs from the digital camera) on the housing for inputting a contact destination to be contacted (column 4, lines 40-60) at end of printing; a printer (220, fig. 3 or fig. 4) in the housing for printing an image on a visible recording medium (prints, column 9, lines 34-40); a first determination unit (the program of the computer 222, column 10, lines 57-65, that determines prints are completed, column 4, lines 45-60, fig. 3, column 13, lines 1-15) determining whether printing by said printer has ended; and a transmitting unit (NCU 227, column 13, lines 1-15), which is responsive to a determination by said determination unit that printing has ended, for transmitting data indicating that printing has ended to a data processing unit outside the housing and, specified by the contact destination input by said input unit, via a communication channel (e-mail or phone, column 13, lines 1-15, column 4, lines 50-60).

Although Tamura teaches unit 210 and unit 220 are united solidly, and it is well-known in the art that things that are united solidly probably are under a same housing, Tamura does not specifically disclosed that.

Parulski, in the same area of ordering and printing photographs from a digital camera, teaches it is well known in the art to have the printing unit and ordering unit to

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be enclosed in a Kiosk, and Attenberg teaches a Kiosk enclosed all its components in one housing (fig. 1).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Tamura to include the unit 210 and unit 220 in a housing.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Tamura by the teaching of Parulski and Attenberg because integrating all components in one housing would 1) reduced space, such that rent would be reduced for commercial vendors, 2) the system would be well-protected; and 3) let users known it a system as a whole for convenient.

Regarding claim 2: Tamura teaches wherein said data processing unit is capable of short-distance communication with said print system (column 10, lines 28-34), said input unit receives identification data, which identifies said data processing unit (column 4, lines 42-45), as the contact destination transmitted from said data processing unit by short-distance communication (column 3, lines 21-25), and the transmitting unit transmits the data indicating that printing has ended to said data processing unit, which is identified by the identification data, by short-distance communication (column 5, lines 1-11).

Regarding claim 3: Tamura teaches the system according to claim 2, further comprising an image data receiving unit for receiving image data transmitted from said data processing unit by short-distance communication (column 2, lines 20-40, column 10, lines 29-34), wherein said printer records an image represented by the image data,

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which has been received by said image-data receiving unit, on a visible recording medium.

Regarding claim 10: Tamura teaches the system according to claim 1, further comprising: a media inserting unit for inserting a medium storing image data; wherein said printer prints the image represented by the image data recorded on the inserted medium on the visible recording medium (column 17, lines 1-10).

Although such disclosure is used for another embodiment disclosed on fig. 9, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the invention disclosed in fig. 3 and 4 to include a media inserting unit for inserting a medium storing image data; wherein said printer prints the image represented by the image data recorded on the inserted medium on the visible recording medium. Such modification is obvious because Tamura already realized image data can be printed not only in a digital camera, but would also be printed by storing the image data in a recording medium and insert the recording medium into a printer device for printing.

Furthermore, Parulski teaches it is well known in the art to have a print order system to received image data from a digital camera as well as from a recording medium (column 2, lines 55-67, column 3, line 67, column 4, lines 1-2, column 2, lines 12-18).

Regarding claim 11: Tamura teaches the system according to claim 1, further comprising: a display unit for displaying the contact destination received by said input unit (column 4, lines 42-45, column 2, lines 44-46, column 12, lines 53-63).

Claims 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al (US 6,771,896) in view of Wu et al (US 6,292,307).

Regarding claims 12, 13: Tamura teaches a print system (the system of the digital camera, order counter 210 and the printing device 220, column 9) comprising: operating buttons (column 20, lines 10-14) for inputting a contact destination to be contacted at the end of a printing (column 4, lines 40-60); a printer (220, fig. 3) for printing images on visible recording media (column 16, lines 64-65); a determination unit (the control unit of column 13, lines 1-15 that detects the end of printing) for determining whether the printing by said printer has ended; and (NCU 28, column 13, lines 10-13) a transmitting unit (NCU 28, column 13, lines 10-13) responsive to a determination by said determination unit that the printing has ended for transmitting to a data processing unit via a communication channel data indicating that the printing has ended.

Tamura does not teach a keypad for inputting information.

However, Wu teaches it is well-known in the art to use a keypad for inputting information for a digital camera (column 1, lines 55-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Tamura's digital camera to use keypad for inputting information.

Such modification would have allowed digital camera with keypad to make use of Tamura's invention to increase the market share of Tamura's invention to increase profit.

Furthermore, Tamura teaches to enter email address or phone number of a user (column 9, lines 58-62, column 13, lines 1-17).

Since the most efficient method of entering numbers (phone number) or character (e-mail address) is by using keypad (most computer and telephone in the market are using keypads including the computer and telephone system in the USPTO and law firms), modifying Tamura's digital camera of using a keypad would have allowed users of entering numbers and characters easily and faster; some users may have memorized the position of the letters and numbers on the keypad.

Note: A keypad is a separate section on some computer keyboard, grouping together numerical keys and those for mathematical or other special functions in an arrangement like that of a calculator according to dictionary.com.

(10) Response to Argument

Appellant, on page 7, lines 4-14, brief, argues: the examiner appears to rely on Official Notice to establish that "things that are solidly united probably are under a same housing." Applicant respectfully submits that this statement is not capable of "instant and unquestionable demonstration" as would be required in order for a fact to be officially noticed. MPEP 2144.03. Furthermore, no technical line of reasoning has

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been provided in support of this reliance on Official Notice as required by MPEP 2144.03.

In response: Column 15, lines 25-30, Tamura et al (US 6,771,896) teaches both order counter 210 and printing apparatus 220 may either be united solidly or arrange to be separate.

According to dictionary.com, solidly means: “whole or entire”, “without separation or division.” United means to “join, combine, or incorporate so as to form a single whole or unit.”

The solidly united unit, that comprises the order counter and printing apparatus, must have outer most surfaces. The examiner interprets the “outer most surfaces” surrounding the solidly united unit to be the “housing” of the solidly united unit. Such interpretation is not based on official notice.

Appellant, on the bottom of page 6, the top of page 7, brief, argues placing the Tamura's printing apparatus 220 and counter 210 in a housing does not result in an input unit on a housing and a printer in the housing.

In response: The examiner is not placing the printing apparatus 220 and order counter 210 in a housing. The examiner is calling the outer most surfaces surrounding the solidly united unit of Tamura's printing apparatus 220 and counter 210 of Fig. 3 a “housing.” Furthermore, fig. 8, fig. 2, fig. 6 of Tamura teaches how a solidly united unit looks like. They all have an outer surface/housing.

Tamura teaches users enter print order information including a phone number or pager number into the camera (column 1, lines 5-10, column 4, lines 43-45, column 7,

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lines 5-10, column 12, lines 53-62), places the camera ON the housing of the order counter 210 (column 5-16), presses order button of the camera; and the order information is input to the solidly united unit of Tamura's printing apparatus 220 and counter 210, through order receiving unit 211. Fig. 4 shows order receiving unit 211 is ON the housing.

The solidly united unit of Tamura informs the print orderer/user when prints are completed (column 13, lines 1-5).

Due to the broad nature of claim 1, Tamura teaches at least two input unit on the housing for inputting a contact destination to be contacted at end of printing. First, order receiving 211 that allows contact destination (phone or pager number) to be contacted at end of printing, to be inputted into the system. Secondly, the camera is also an input unit allowing user to enter contact destination (phone or pager number) to be contacted at end of printing. (note: the examiner is treating the camera of Tamura as part of the print system).

Fig. 3, Tamura, clearly showing a printer 223 inside the housing of printing apparatus 220. (also see 220 of fig, 4). Therefore, printer 223 would also be located inside the housing of the solidly united unit that comprises the printing apparatus 220 and counter 210.

Appellant, on bottom of page 7, page 8, brief, argues: the examiner relies on Parulski and Attenberg to show an input device and a printer in a housing and there are no motivation to combine the references.

In response, the teaching of placing the input unit on a housing and a printer in the housing is taught by Tamura et al (please see above discussion).

Tamura, column 15, lines 25-30, teaches the both order counter and printing apparatus may either be united solidly or be arranged to be separate. All the drawing of Tamura is showing the embodiment that both order counter and printing apparatus are arranged to be separate. Tamura does not show a drawing of the embodiment that both order counter and printing apparatus are united solidly.

As previously discussed, from the teaching of Tamura, a person with ordinary skill in the art can logically and reasonably expect to see the solidly united unit of order counter and printing apparatus has a housing with the input unit (camera or order receiving unit 211) on the housing and printer 223 in the housing.

Parulski is used to show that a system that is similar to Tamura (column 2, lines 65-67, column 3, lines 1-2, fig 1), teaches a camera directly communicate with kiosk 16 through a host interface 30 for ordering prints. The kiosk has input unit (e.g., direct interface) for inputting/ordering print data to a microprocessor and the processor controls the printing of the print data with a printer. Parulski does not show how a kiosk looks like.

Attenberg is used to show how a kiosk looks like. Fig. 10 shows that a kiosk has a housing protecting/enclosing all vital components except the user interface. Such disclose is similar to Tamura's, camera of fig. 2, fig. 8; printing apparatus of fig. 4; order counter 210 of fig. 4, fig. 6. They all have a common property; the property of having all the vital components solidly united in a housing with user interface on the housing.

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Assuming Tamura does not teach the solidly unit of unit 210 and unit 220 are in a housing (examiner believes Tamura already teaches that or at least a person with ordinary skill in the art would reasonably expect such a result from the teaching that unit 210 and unit 220 are solidly united), it would still have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Tamura to include the solidly unit of unit 210 and unit 220 in a housing, based on the teaching of Parulski and Attenberg.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Tamura by the teaching of Parulski and Attenberg because integrating all components of the printing apparatus 220 and counter 210 in one housing with input unit/user interface on the housing and printer 223 in the housing would: 1) reduced space, such that rent would be reduced for commercial vendors, 2) components of the system would be well-protected; and 3) let users know it a system as a whole for convenient.

Appellant, on page 9, brief, argues (claim 2): no data indicating that printing has end is transmitted by Tamura's system.

In reply: Column 13, lines 1-12, Tamura, clearly teaches data indicating completion of prints is transmitted to the user.

Appellant, on page 9, brief, argues (claim 11): Parulski does not show a display for displaying contact information received by the input unit.

In reply: Tamura, column 2, lines 43-46, teaches a display of displaying print information, prepared by the user, received by the system; including a phone number or

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email address, column 4, lines 42-45, column 9, lines 58-62, column 13, lines 1-17. The phone number or email address is the contact destination.

Appellant, on page 10, brief, argues (claim 12, 13) there are no motivation of combining Tamura and Wu.

In reply: Tamura teaches every limitation of claims 12, 13 except a keypad for inputting information for the digital camera.

However, Wu teaches it is well-known in the art to use a keypad for inputting information for a digital camera (column 1, lines 55-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Tamura's digital camera to use keypad for inputting information.

Such modification would have allowed digital camera with keypad to make used of Tamura's invention to increase the market share of Tamura's invention to increase profit.

Furthermore, Tamura teaches to enter email address or phone number of a user (column 9, lines 58-62, column 13, lines 1-17).

Since the most efficient method of entering numbers (phone number) or letters (e-mail address) is by using keypad (most computer and telephone in the market are using keypads including the computer and telephone system in the USPTO and law firms), modifying Tamura's digital camera of using a keypad would have allowed users of entering numbers and characters easily and faster; some users may have memorized the position of the letters and numbers on the keypad.

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Note: A keypad is a separate section on some computer keyboard, grouping together numerical keys and those for mathematical or other special functions in an arrangement like that of a calculator according to dictionary.com.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

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